

Appl. No. : 10/029,607  
Filed : December 20, 2001

### REMARKS

Applicant has the following amendments and remarks in response to the Office Action.

#### Discussion of Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

In the Office Action, the Examiner rejected Claims 1-3 and 10-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which Applicant regards as the invention.

In particular, with respect to issue (i) raised by the Examiner, the Examiner stated that the scope of the terms “contains, as resin” recited in Claims 1 and 11 was unclear. Applicant has deleted this phrase from the above-claims. With respect to issue (ii), in Claim 2 (now Claim 1), the Examiner stated that it is unclear whether the phrase “chosen from a group of” is intended to set forth a listing of Markush group elements. Applicant submits that this listing is a Markush group of elements.

With respect to issue (iii), the Examiner stated that it was unclear whether Claim 3 means “said resin coating further contains.” To correct this issue, Applicant has deleted the term “contains” and added “further comprises.”

In issue (iv) raised by the Examiner, he stated it was unclear whether the recited relative mass amounts refer to the composition of the finished coating composition or to the composition of a solution that is to be applied to the metallic plate material or both. Applicant has amended Claim 11 to clarify that the weight percentages relate to the composition of the water thinnable coating material.

In addition, with respect to issue (v), the Examiner stated that the phrase “the solid component” lacks antecedent basis. Applicant has corrected the antecedent basis of the above claims with respect to this issue. With respect to issue (vi), the Examiner stated that it is unclear what is the mass percent basis since the percent of water is limited to 50% mass percent at most and the solid component could be only 40% at most. Applicant respectfully submits that other non-claimed solids and liquids, other than what can constitute portions of the water thinnable coating material can be included in the coating material.

With respect to issue (vii), the Examiner stated that the term “using” is unclear. Applicant has amended this to recite “comprising”.

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Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1, 3, 11, 13, 16, 18, and 20 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. 0 613 931 A2, to Gosselin, et al. (hereinafter "Gosselin").

In the Office Action, the Examiner rejected Claims 2 and 12 for only non-prior art reasons under 35 U.S.C. § 112 and therefore assumes that once these defects have been removed, that these claims are in condition for allowance. Applicant respectfully submits that the cited prior art fails to teach or suggest the use of the components that are recited with respect to Claim 2. Gosselin discloses a method of forming a chromium bearing organic coating in which an aqueous solution of a water dispersible or emulsifiable thermosetting resin is applied on a steel sheet, and then the steel sheet is induction heated at a temperature of 149°C to 227°C.

In the Applicant's invention, a coating is formed without preheating as performed in Gosselin. The composition of the coating is as stated in claim 1. Specifically, the coating formed in the Applicant's invention does not contain a chromium compound at all, which is an essential component of the coating of Gosselin. Further, the coating in the Applicant's invention contains an acrylamide substance as an essential component, while Gosselin does not even suggest this substance. Hence, the Applicant's invention is not obvious from Gosselin.

Furthermore, this limitation is not taught or suggested by Anderson. For similar reasons to those mentioned above, the Applicant's invention is not obvious from Anderson. Only, Anderson mentions an example in which the bake temperature at which the coating is baked is 390°F to 450°F (col. 11, lines 61 to 63).

The metallic plate material according to the Applicant's invention is used as a material for a casing for containing parts of an electric/electronic instrument. In contrast, neither Gosselin nor Anderson makes the use for their material clear. Hence, the use for the Applicant's material cannot be obvious from Gosselin and Anderson. Applicant respectfully submits that Claims 1 and 11, have been amended respectively to include the limitations of these claims. Furthermore, the defects under 35 U.S.C. § 112, have been corrected by the above-amendments as discussed in the above section.

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Applicant furthermore presents new Claim 22. Claim 22 recites the use of a urethane-based resin. Applicant respectfully submits that this is not taught or suggested in isolation or in combination by Gosselin and Anderson.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

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